

## REMARKS

### I. INTRODUCTION

Favorable reconsideration of this application, in light of the present amendments and the following discussion, is respectfully requested.

### II. STATUS OF THE CLAIMS

Claims 1-2, 7-8, 10-17, 20-21, 26, 29-30, and 33-36 are pending. Claims 1 and 29 are independent. Claims 1, 8, 10-11, 16, 20-21, 23-24, 26, 29, and 33-35 are amended herein, and claim 36 is newly added. No new matter is added by this amendment.

### III. SUMMARY OF THE OFFICE ACTION

In the outstanding Office Action, claims 10, 11 and 33 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite; claims 1-2 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,062,111 to Wershe; claims 1-2, 7, 8, 10, 11, 20, 21, 23, 24, 26 and 33-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DE 10013829 to Pfister; claims 12-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pfister and U.S. Patent No. 1,139,119 to Heidenreich; and claims 29, 30 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pfister and U.S. Patent No. 5,787,731 to Ebara.

### IV. ARGUMENTS

#### A. Summary:

The cited prior art fails to disclose, teach, suggest, or render obvious a top with a stem that has a cross shape, as recited in independent claim 1. Also, the prior art fails to teach or

render obvious the latching mechanism of independent claim 29. Each rejection is addressed in detail below.

**B. The Rejection of Claims 10-11 and 33 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph:**

The Office Action rejects claims 10-11 and 33 under 35 U.S.C. § 112, second paragraph as being indefinite for depending from cancelled claims. Claims 10-11 and 33 have been amended to depend from either pending claim 1 or pending claim 29, as suggested by the Examiner. Accordingly, it is respectfully requested that the rejection of claims 10-11 and 33 under 35 U.S.C. § 112, second paragraph be withdrawn.

**C. The Rejection of Claims 1-2 and 7 under 35 U.S.C. § 102**

The Office Action rejects claims 1-2 and 7 under 35 U.S.C. § 102(b) as anticipated by Wershe. For the reasons discussed below, this rejection is respectfully traversed.

Independent claim 1, as amended, recites a spinning top comprising, among other elements, a body and a stem, wherein the stem includes a main portion and at least one transverse portion such that the stem has the shape of a cross. Furthermore, the stem of the claimed invention, in a second position, extends through an opening formed in the body in a direction generally perpendicular to the main axis of the body. For example, in Fig. 2 of the present invention, the stem, having a main portion 2 and a transverse portion 6 to form a cross, extends through an opening 5, perpendicular to the body 1.

Wershe does not disclose, teach or suggest a stem with a cross shape, as claimed. In Figs. 1, 2, 6, and 7 of Wershe, the stem 18 has an L shape, not a cross shape, as recited in the claimed invention. In addition, as shown in Fig. 7, the stem 18 is not perpendicular to the main axis of the body 12 when in its the second position. One of ordinary skill in the art

would recognize that the main axis of the body 12 is on the main surface 31 rather than the side or thickness of the body 12. Thus, in Fig. 7 of Wershe, with the stem 18 being inserted into the hole 32 on the side of the body 12, the stem 18 is perpendicular to the side of the body 12, rather than the main axis of the body as recited in the claims.

Anticipation requires that every limitation of a claim must identically appear in a prior art reference. See *Gechter v. Davidson*, 43 U.S.P.Q. 2d 1030, 1032 (Fed. Cir. 1997). It is clear that the limitations of a stem with a cross shape and the perpendicular coupling between the stem and the body in the second position do not identically appear in Wershe. Absence from the prior art reference of any claimed element negates anticipation. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

It is, therefore, respectfully submitted that because all of the claimed elements are not found in Wershe, Wershe fails to anticipate claim 1. Thus, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. § 102(b) based on Wershe be withdrawn.

Dependent claims 2 and 7 are believed to be allowable for the same reasons. Moreover, these claims recite additional features not found in the prior art.

**D. The Rejection of Claims 1-2, 7-8, 10-11, 20-21, 23-24, 26 and 33-34 under 35 U.S.C. § 103 over Pfister:**

Claims 1-2, 7-8, 10-11, 20-21, 23-24, 26 and 33-34 stand rejected under 35 U.S.C. § 103 as unpatentable over Pfister. For the reasons discussed below, this rejection is respectfully traversed.

Independent claim 1, as amended, recites, among other elements, that the stem has the shape of a cross and that the outer perimeter of the body is substantially continuous. For

instance, Fig. 2 shows that the stem 2 has a cross shape and the body 1 has a substantially continuous outer perimeter, i.e., no gaps.

In Pfister, the stem 11 appears to include a handle 112, a ring 110, pivots 119 and a pointed head 114. As seen in the figures of Pfister, the stem 11 does not have the shape of a cross, as recited in the claimed invention. The stem 11 instead includes the ring 110 which is not a transverse portion that forms a cross. Therefore, Pfister does not read on the claimed invention.

Moreover, the outer perimeter of the body 12 of Pfister has a wide gap 120. Thus, the perimeter of the body 12 is not substantially continuous as claimed. Moreover, it would not have been obvious for one of ordinary skill in the art to create a continuous perimeter for the body 12 in Pfister because the gap 120 is a necessary feature in Pfister in order for the handle 112 of the stem 11 to rotate, fold down, and fit into the gap 120.

In the rejection, page 4 of the Office Action, the Examiner states that the body 12 of the jewelry in Pfister has a substantially continuous outer perimeter. The Examiner fails address the fact that the perimeter of the body 12 has the gap 120, hence no continuity for the perimeter. It is respectfully requested that the gap 120 be addressed or the rejection be withdrawn for not having all the features recited in the claims.

At least for the reasons discussed above, a prima-facie case of obviousness has not been established. Pfister does not disclose, teach or suggest a spinning top having the features claimed in independent claim 1. It is, therefore, respectfully submitted that claim 1 is patentable over Pfister and the rejection under 35 U.S.C. § 103 be withdrawn.

Dependent claims 2, 7-8, 10-11, 20-21, 23-24, 26 and 33-34 are believed to be allowable for the same reasons. Furthermore, these claims recite additional features not found in the prior art.

**E. The Rejection of Claims 12-17 under 35 U.S.C. § 103 over Pfister and Heidenreich:**

Claims 12-17 depend from claim 1. Because claim 1 is distinguished over Pfister for the reasons discussed above, claims 12-17 are also distinguished over Pfister.

In addition, claim 16 recites that the body has a lip or flange, and the outer element is received inside the lip or flange. In Heidenreich, the body 6 does not have a lip or flange, and the outer element 9 covers outside the perimeter of the body 6. Thus, Heidenreich does not teach or suggest the connection of the outer element as recited in claim 16.

**F. The Rejection of Claims 29, 30, and 35 under 35 U.S.C. § 103 over Pfister and Ebara:**

In the Office Action, claims 29, 30 and 35 are rejected under 35 U.S.C. § 103 over Pfister in view of Ebara. For the reasons discussed below, this rejection is respectfully traversed.

Independent claim 29 recites a spinning top comprising, among other elements, a stem having first latch member and a body having a second latch member, wherein the first and second latch member are engageable to prevent rotation of the stem with respect to the body.

Pfister discloses an earring 1 which includes a stem 11 having pivot pins 119 and a body 12 receiving the pivot pins such thereby allowing the stem 11 to rotate with respect to the body 12. Pfister does not have the first and second latch members as claimed. Ebara fails

to cure the deficiencies of Pfister. Ebara teaches a ring having a rotatable member 4 (Figs. 6 and 7) with axle 19 and slot 20, and a body (Figs. 4 and 5) having a hole 10 and a projection 11. The axle 19 is inserted into the hole 10 and the projection 11 sits inside the slot 20 to preventing the member 4 from rotating.

The Examiner suggests that it would have been obvious to one of ordinary skill in the art to utilize the locking element of Ebara in Pfister in order to achieve the predictable result of preventing rotation of the elements. Such a rejection is respectfully traversed.

In Pfister, the stem 11 must rotate with respect to the body 12. The presence of the pivot pins 119 and the gap 120 which receives the portion 112 show that stem 11 is intended to rotate inside the body 12. In contrast, in Ebara, the deep slot 20 includes sharp edges for permanent locking. Once the projection 11 sits inside the slot 20, the deep, sharp edges of the slot prevents the projection 11 from rotating. Thus, the element 4 of Ebara cannot be moved after it is being locked. Therefore, the locking mechanism of Ebara teaches away from the intent of Pfister. See MPEP § 2143.01V. Accordingly, it would not have been obvious to one of ordinary skill in the art to combine Ebara and Pfister, as suggested.

None of the other cited prior art references, taken singly or in combination, shows, teaches, or suggests the combination of elements recited in independent claim 29 of the present invention. It is, thus, respectfully submitted that a *prima facie* case of obviousness has not been established for claim 29. Accordingly, it is respectfully requested that the rejection to claims 29 over Pfister and Ebara be reconsidered and withdrawn.

Dependent claims 30, 33 and 35 are believed to be allowable for the same reasons. Moreover, these claims recite additional features not found in the cited prior art.

V. CONCLUSION

In view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage of fees or credit any overpayment thereof to BLANK ROME LLP, Deposit Account No. 23-2185 (001058-00025). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this report, Applicant hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

By: Tara L. Laster  
Tara L. Laster  
Reg. No. 46,510  
Attorney for Applicants

BLANK ROME LLP  
600 New Hampshire Avenue N.W.  
Washington, D.C. 20037  
Telephone: (202) 772-5800  
Facsimile: (202) 772-5858

Date: June 5, 2008